

REMARKS

Claims 1-39 are pending in the application. Claims 1, 22, 28 and 35 are the only independent claims.

The Examiner has allowed claims 22-27 and 35-39.

Claims Rejections - 35 U.S.C. § 101

Claims 1-16, 18-21, and 28-34 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The Examiner maintains in particular that the invention set forth in those claims does not result in the transformation of an article or physical object nor does the invention provide a practical application that produces a useful, concrete and tangible result.

The Examiner contends that the rejected claims are directed to an abstract idea. The Examiner then states that such claims must have either physical transformation or a useful, concrete and tangible result. The Examiner concludes in part that the claims fail to include a transformation from one physical state to another.

Applicants respectfully traverse the Examiner's application of the law and her conclusion that the rejected claims do not meet the definition of statutory subject matter.

Contrary to the Examiner's position, claim 1 *clearly* recites the transformation of a physical object. Claim 1 recites, in pertinent part "applying a droplet of a specimen-containing solvent to the sample support surface" and "evaporating the solvent from the droplet at a rate permitting formation of a ring-like region of enhanced specimen deposit on the sample support surface." In the first step, a droplet is applied to a sample support surface. The surface changes from an empty or clean surface to a surface holding a droplet. In the second step the solvent in the droplet is evaporated, leaving a "ring-like region of enhanced specimen deposit on the

sample support surface." The support surface *undergoes a physical transformation* from a clean or pre-deposit state to a state containing a ring-like specimen region.

Claim 28 contains the same description of a physical transformation. Like claim 1, claim 28 is not directed to an abstract idea. Claim 28 contains physical steps that act on physical objects, changing those physical objects in the process of the claim.

In this circumstance, contrary to the contention of the Examiner, it is not necessary for the claims to recite a useful, concrete and tangible result. The useful, concrete and tangible result test is applicable only in cases where all of the steps are mental steps (no transformation of an article or physical object). That is not the case here.

Even if the useful-concrete-and-tangible-result test were applicable here, applicants' claims 1 and 28 would satisfy the test. Pursuant to the decisions of the courts, such as *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 47 U.S.P.Q.2d 1596, (Fed.Cir. 1998), that test is satisfied if the result produced by a claimed method has a real world practical use or application. In this case, applicant's claimed invention produces a useful, concrete, and tangible result because the result of applicants' claimed process, namely, a spectral sample that characterizes or identifies the specimen in the ring on the sample support surface, has a real world practical use or application. Applicants' claims need not indicate the use to which the result is put, just the result itself.

The Examiner directs applicants' attention to the second and third sentences of part C.2.(2) of Section IV of MPEP 2106, "DETERMINE WHETHER THE CLAIMED INVENTION COMPLIES WITH 35 U.S.C. SEC. 101". However, the Examiner should apply part C.2.(2) of Section IV *only after* applying part C.2.(1), which states "USPTO personnel first shall review the claim and determine if it provides a transformation or reduction of an article to a

different state or thing. If USPTO personnel find such a transformation or reduction, USPTO personnel shall end the inquiry and find that the claim meets the statutory requirement of 35 U.S.C. 101." (Emphasis added.) In this case, claims 1 and 28 clearly provide a transformation or reduction of an article to a different state or thing. The support surface *undergoes a physical transformation* from a clean or pre-deposit state to a state containing a ring-like specimen region. That observation should end the §101 inquiry. Claims 1 and 28 set forth statutory subject matter. There is no need to go further. There is no need to go on to part C.2.(2) of Section IV of MPEP 2106. Part C.2.(2) is irrelevant.

Accordingly, rejected claims 1-16, 18-21, and 28-34 do in fact describe patentable subject matter under 35 U.S.C. § 101.

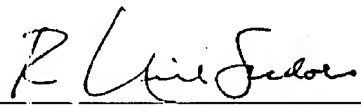
Conclusion

For the foregoing reasons, claims 1-16, 18-21, and 28-34 are deemed to be in condition for allowance. An early Notice passing the application to issue is earnestly solicited.

Should the Examiner believe that direct contact with applicant's attorney would advance the prosecution of this application, the Examiner is invited to telephone the undersigned at the number below.

Respectfully submitted,

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